IN THE

Supreme Court of the United States

CHARLES ELMORE C

October Term, 1951.

No. 496

KENNETH B. THOMPSON,

Petitioner,

vs.

CHARLES H. LEARNED,

Respondent.

Petition for Writ of Certiorari to the United States Court of Customs and Patent Appeals and Brief in Support Thereof.

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PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF CUSTOMS AND PATENT APPEALS.

To the Honorable the Chief Justice and Associate Justices of the Supreme Court of the United States:

Your Petitioner, Kenneth B. Thompson, respectfully prays for a writ of certiorari for review of the Decree of the United States Court of Customs and Patent Appeals in the above-entitled cause, reversing the decision of the Board of Interference Examiners of the United States Patent Office and awarding to Respondent priority of invention of a signaling mirror which both Petitioner and Respondent independently submitted to the Government for use in sea rescue operations during World War II.

Jurisdiction.

1. The statute under which the jurisdiction of this Court is invoked is Title 28, U. S. Code, Section 1256.

2. The Judgment of the Court of Customs and Patent Appeals was entered June 29, 1951 [R. 689, 707], the opinion being reported at 191 F. 2d 409. Timely Petition for Rehearing was filed July 25, 1951 [R. 708], and denied September 28, 1951 [R. 724].

3. The Judgment was rendered in an appeal from a final decision of the Patent Office rendered under Revised Statute, Section 4904 (U. S. C., Title 35, Sec. 52), to determine the issue of priority of invention in an interference.

4. Cases believed to sustain the jurisdiction are:

Magnum Import Co. v. Coty, 262 U. S. 159, 163, 67 L. Ed. 922, 924;

Clifton v. United States, 4 How. 242, 45 U. S. 242, 11 L. Ed. 957;

Electric Storage Battery Company v. Shimadzu, et al., 307 U. S. 5; 83 L. Ed. 1071.

A certified transcript of the record in the case including the proceedings in the Court of Customs and Patent Appeals accompanies this petition in compliance with Rule 38 of the Rules of this Court.

Questions Presented.

Question No. 1. When a party seeks to sustain his burden of proof by his own oral testimony on cross-examination about letters in his possession or control, does not his failure to introduce the letters in evidence create the presumption that if introduced they would have been adverse and detrimental to his case?

Question No. 2. Did a party having the burden of proving that the Government in reducing an invention to practice was acting as his agent, succeed in proving the agency by his own oral testimony during cross-examination, of the existence and contents of correspondence with the Government, in his possession or control, without producing the correspondence?

Question No. 3. Did an inventor abandon his invention so as to foreclose himself from obtaining a patent, under the circumstance that he conceived and built a model of his invention in 1933, followed by complete inactivity for a ten-year period during which time he admittedly suppressed the invention and considered that it should be forgotten, after which he sent a letter disclosing it to the National Inventors' Council in March, 1943, and did nothing more until he filed his patent application on May 11, 1944, at the Government's request, after a rival inventor made the same invention and submitted it to the Office of Strategic Services in the fall of 1943?

Summary Statement of the Case.

This action involves an Interference No. 82,373, set up in the Patent Office as a consolidation of two interferences, for the purpose of determining priority of invention among patent applications of four parties all adverse to each other: Kenneth B. Thompson; Charles H. Learned; Larry B. Young; and Richard S. Hunter, an employee of the Bureau of Standards and assignor to the United States Government.

In the Patent Office judgment was entered against Young. After the motion period during which Hunter unsuccessfully moved to dissolve the interference, the Government made a settlement with Respondent Learned by which the Government took control of the prosecution of the Learned application. Thereupon the Government filed an abandonment of the contest in behalf of Hunter, and worked to defeat Petitioner by combining the proofs of both Hunter and Learned in behalf of Respondent Learned. Testimony was then taken, pursuant to which both the Board of Interference Examiners and the Court of Customs and Patent Appeals held that Learned conceived the invention in 1933 as evidenced by a model of the device, Learned Exhibit 8; and that Hunter reduced the same invention to practice on February 7, 1944, as evidenced by another device, Learned Exhibit 4, built by Hunter in the Bureau of Standards. During the testimony, the Department of Justice called upon Hunter to testify, contrary to his sworn preliminary statements, that Learned and not Hunter was the inventor, and that Hunter's reduction to practice belonged to Learned.

Evidence was introduced in behalf of Learned seeking to prove an agency relationship between Learned and the

Government, necessary to credit Hunter's reduction to practice to Learned; and for this purpose Learned introduced the following evidence:

1. Learned's letter, Exhibit 10, of March 21, 1943, to the National Inventors' Council, disclosing the invention and offering to allow the Government to use it [R. 118, 121];

2. The facts that the National Inventors' Council sent the letter to Hunter about January 11, 1944, after which Hunter built his device, Exhibit 4, embodying the principle in the letter and successfully tested it on February 7, 1944, at the Naval Training Station, Pensacola, Florida.

On the cross-examination of Learned, Petitioner discovered that there were three more letters in the possession or control of Learned or his counsel, but not in evidence, bearing on the question of whether an agency was accepted or established. By Learned's testimony, these were: A reply in June, 1943, by the National Inventors' Council to the letter of March 21, 1943, to the effect that the Government did not consider it a sufficient improvement to warrant development [R. 128, 129]; a letter of inquiry from the National Inventors' Council to Learned in January, 1944, indicating the advisability of developing the invention and asking Learned's attitude toward making it available to the Government among other questions [R. 129, 130]; Learned's reply containing "a statement indicating what I considered my invention to be and stating that I wanted it to be freely available to the United States for what use they might make of it" [R. 130, 131].

The decision of the Board of Interference Examiners [R. 613], awarded priority to Petitioner, one member dissenting, on the ground that Respondent had not overcome the earlier filing date, April 18, 1944, of the Thompson patent application, because Respondent had failed to prove the agency necessary to credit him with Hunter's reduction to practice on February 7, 1944. The Board held that the letter from the National Inventors' Council in June, 1943, terminated whatever agency relationship had been established by Learned's letter of March, 1943 [R. 623]; and that the Council's letter of January, 1944, apparently sought to reestablish a relationship which even by Learned's testimony was not reestablished until his reply "either late in January or early in the month of February, 1944," which was not proven to be before the Government completed the reduction to practice on February 7, 1944 [R. 627].

A basic reason for the Board's ruling that no agency was proven was "the failure to introduce the correspondence in evidence," the Board holding:

> "in accordance with well established legal practice it can only be taken as a tacit admission that the contents thereof would have been adverse to Learned" [R. 619].

The Court reversed the Board and awarded priority to Learned by giving such weight to Learned's testimony as to find the existence of an agency "at least as early as January, 1944" [R. 704] thereby crediting Hunter's reduction of February 7, 1944, to Learned. This caused Respondent to overcome Petitioner's filing date of April 18, 1944, as the concurrent findings of the Board and of the Court were that Petitioner's work and submission of

the invention to the Office of Strategic Services in the fall of 1943 proved only conception but not reduction to practice.

The Court's decision [R. 698] recognizes the general rule of law that failure of a party to produce evidence which is available to him and is more explicit, direct and satisfactory than he does produce, creates the presumption that the better evidence would have been unfavorable or adverse to him. But the Court's opinion was that in the present case, Learned's testimony about the agency should be given full weight without detriment from the best evidence rule because of the fact that the existence of the correspondence not in evidence was discovered by cross-examination by Petitioner's counsel who did not demand its production [R. 699].

In respect to the question of Learned's abandonment, laches and suppression of his invention, the Board held that Learned had admittedly suppressed it after his conception in 1933 and did not file his patent application until suggested by the Government in April, 1944; but declined to refuse him priority on that ground because Thompson failed to prove that Learned's or the Government's desire to file was induced by knowledge of Thompson's submission of his invention to the Office of Strategic Services in 1943 [R. 628].

The Court made no finding at all on the question of Learned's abandonment, although the matter was presented as requiring decision in the event the Court should reverse the Board on the question of the agency [R. 683, 686, 720, 721].

Reasons Relied on for Allowance of the Writ of Certiorari.

The discretionary power of this Court is invoked upon the following grounds:

1. The Court of Customs and Patent Appeals has permitted Respondent to overcome the presumption and evidence of adverseness between himself and Hunter by proving the agency solely by his oral testimony of the existence and contents of letters in his possession or control alleged to have been written in January or February 1944, without producing the letters. This conflicts with the general rule of evidence stated in 31 Corpus Juris Secundum, Section 156, page 850, and in Jones on Evidence, Fourth Edition, Volume 1, Section 19, page 49, that a party is required to prove his case by the best evidence available to him, and that his failure to do so creates the presumption that the better evidence, if introduced, would be adverse to his case. The Court's decision conflicts with the rule of evidence set forth in the decision of this Court in *Clifton v. United States,* 4 How. 242, 45 U. S. 242, 11 L. Ed. 957, 960, and in the decision of the Court of Appeals for the Ninth Circuit in *Backus v. Owe Sam Goon,* 235 Fed. 847. It is also in direct conflict with the rule set forth in the earlier decision of the Court of Customs and Patent Appeals in *Longini Shoe Manufacturing Co. v. Ratcliff,* 108 F. 2d 253, which is not overruled nor mentioned in the instant decision.

2. In not refusing to award Respondent priority because of his abandonment, the Court's decision is in con-

flict with Revised Statute Section 4886 (U. S. C. Title 35, Sec. 31), and with decisions of this Court on abandonment of inventions, as set forth in *Electric Storage Battery Company v. Shimadzu, et al.,* 307 U. S. 5, 83 L. Ed. 1071, and *Kendall v. Winsor,* 21 How. (62 U. S.) 332, 328, 16 L. Ed. 165.

3. Questions Nos. 1 and 2 involve a matter of legal practice of great importance to the Public and the Bar in all branches of the law, and the decision of the Court of Customs and Patent Appeals leads to confusion and uncertainty about it.

Question No. 3 is of great importance to the Public in the field of Patent Law, and it should be determined whether an inventor forecloses himself, by abandonment, from obtaining a patent under the circumstances stated in this Question.

In the event of granting this Petition, none of the technical aspects of the invention nor findings on conception or reduction to practice will be discussed, and only the minor part of the record relating to Questions 1, 2 and 3 will be considered.

For the foregoing reasons, it is respectfully submitted that this petition for a writ of certiorari should be granted.

D. Gordon Angus,
Attorney for Petitioner.

State of California, County of Los Angeles—ss.

D. Gordon Angus, being duly sworn, deposes and says:

That he is the attorney for the Petitioner herein, that he prepared the foregoing Petition and that the allegations thereof are true, as he verily believes.

D. GORDON ANGUS.

Subscribed and sworn to before me this 20th day of December, 1951.

(Seal) MARGARET M. BOUTON,
Notary Public.

My commission expires November 1, 1953.

BRIEF FOR PETITIONER IN SUPPORT OF PETITION FOR WRIT OF CERTIORARI.

The Opinions of the Court of Customs and Patent Appeals and of the Board of Interference Examiners.

The opinion of the Court of Customs and Patent Appeals is reported at 191 F. 2d 409, 91 U. S. P. Q. 57, and appears in the record filed herewith [R. 689]. The Board's opinion appears in the record at pages 613 to 635, and has not been reported.

Statement.

The facts are stated in the Petition.

Statutes.

The statutes under which this case arises are:

Revised Statute, Section 4886 (U. S. C., Title 35, Sec. 31):

> "Any person who has invented or discovered any new and useful art, machine, manufacture, or composition of matter, or any new and useful improvements thereof, . . . not known or used by others in this country, before his invention or discovery thereof, and not patented or described in any printed publication in this or any foreign country, before his invention or discovery thereof, or more than one year prior to his application, and not in public use or on sale in this country for more than one year prior to his application, unless the same is proved to have been abandoned, may, upon payment of the fees required by law, and other due proceeding had, obtain a patent therefor."

Revised Statute, Section 4904 (U. S. C., Title 35, Sec. 52):

> "Whenever an application is made for a patent which, in the opinion of the Commissioner, would interfere with any pending application, or with any unexpired patent, he shall give notice thereof to the applicants, or applicant and patentee, as the case may be, and shall direct a board of three examiners of interferences to proceed to determine the question of priority of invention. And the Commissioner may issue a patent to the party who is adjudged the prior inventor."

Revised Statute, Section 4911 (U. S. C., Title 35, Sec. 59a):

> ". . . If any party to an interference is dissatisfied with the decision of the board of interference examiners, he may appeal to the United States Court of Customs and Patent Appeals: . . ."

Revised Statute, Section 4914 (U. S. C., Title 35, Sec. 62):

> "The court, on petition, shall hear and determine such appeal, and revise the decision appealed from in a summary way, on the evidence produced before the commissioner, at such early and convenient time as the court may appoint; and the revision shall be confined to the points set forth in the reasons of appeal. After hearing the case the court shall return to the commissioner a certificate of its proceedings and decision, which shall be entered of record in the Patent Office, and shall govern the further proceedings in the case. . . ."

Specification of Errors.

The errors which Petitioner will urge if the writ of certiorari is allowed, are that the Court of Customs and Patent Appeals erred:

1. In giving full weight to the oral testimony of Respondent as to the contents of letters in his possession or control and without detriment from the rules relating to the most satisfactory evidence, and withholding evidence.

2. In holding that Respondent did not need to introduce the letters to prove an agency because the existence of the letters was discovered by the cross-examiner who did not demand their production.

3. In holding that an agency relationship was proved to have existed between Respondent and the Government whereby Hunter's reduction to practice inured to the benefit of Respondent.

4. In not holding that Respondent is not entitled to an award of priority because of his abandonment, laches and suppression of the invention before the filing of his patent application.

5. In not affirming the decision of the Board of Interference Examiners awarding priority of invention to Petitioner, and in awarding priority of invention to Respondent.

ARGUMENT.

Argument Relating to Questions 1 and 2.

In order for the Respondent to prevail in the interference he had to prove that Hunter in completing the reduction to practice on February 7, 1944, was acting as Respondent's agent; for it is well established that in the absence of evidence to the contrary it is presumed that different inventors such as Hunter and Learned are working adversely to each other rather than for each other; and in this case there were even Hunter's oath [R. 12] and sworn preliminary statements [R. 674, 675] that he believed himself, rather than Learned, to be the first inventor. The mere fact that Hunter may have derived the idea from Learned's letter of March 21, 1943, to the National Inventors' Council, Learned Exhibit 10, does not alter the presumption of the adverse relationship in the absence of proof of the necessary agency. Both the Board and the Court have agreed or acquiesced in the correctness of the foregoing statement.

On his direct examination Learned attempted to prove the necessary agency solely by his letter of March 21, 1943, but neither the Court nor the Board credited him with an agency on account of it. The Court in holding that Learned had proved the agency at least as early as January 1944 was giving full weight to his testimony on cross-examination concerning two other letters which were not produced or demanded.

The rules of evidence relating to the matter are properly stated in Jones on Evidence, Fourth Edition, Volume 1, Section 19, page 49:

> "Sec. 19. Withholding evidence.—There is a recognized legal presumption that a party will pro-

duce evidence which is favorable to him if such evidence exists and is available. And the mere withholding or failing to produce material evidence which is available and would, in the circumstances of the case, be expected to be produced, gives rise to a natural inference—less forceful than that arising from the destruction, fabrication or suppression of evidence in which other parties have a legal interest but constantly acted upon by the courts—that such evidence is held back because it would be unfavorable or adverse to the party withholding it."

And under "Failure to Produce Most Satisfactory Evidence" in 31 Corpus Juris Secundum, Section 156, page 850:

> "Where it is apparent that a party has the power to produce evidence of a more explicit, direct, and satisfactory character than that which he does introduce and relies on, it may be presumed that if the more satisfactory evidence had been given it would have been detrimental to him and would have laid open deficiencies in, and objections to, his case which the more obscure and uncertain evidence did not disclose."

The Court's reason for holding that the foregoing rules, expressly referred to in its Opinion, do not apply to the present case is as follows:

> "It seems to us that the crux of this case rests upon the weight to be given the testimony of Learned in answer to the questions asked him on cross-examination by counsel for appellee relative to the contents of the written documents which were obviously available. We think the board erred in not giving sufficient weight to the testimony of Learned inas-

much as it was given in response to questions by counsel for Thompson who did not demand the production of the letters referred to." [R. 698, 699.]

"Clearly the documents referred to were available to counsel for appellee. Therefore, he may not now complain concerning their absence from the record. Apparently counsel for appellee was satisfied with the evidence as to the contents of the missing correspondence which was given by Learned during his cross-examination. [R. 700.]

* * * * * * * *

"It is obvious to us that the board gave no weight whatever to that testimony of Learned, treating it as self-serving and of little or no probative value. Again we say that under the circumstances of this case, the best evidence was available and could have been demanded by counsel for appellee who was responsible for bringing the matter into the record. When he failed to do so, however, the testimony of Learned, in the absence of fraud or better evidence, is the best evidence available and is entitled to full weight. [R. 702, 703.]

* * * * * * * *

"We conclude, therefore, that an agency relationship was established between the Government and Learned at least as early as January 1944." [R. 704.]

The Court's decision cites no authority for its apparent holding that when the existence of written evidence is discovered by cross-examination and not demanded there is thus created an exception which suspends the usual operation of the best evidence rule.

In *Clifton v. United States,* 4 How. 242, 45 U. S. 252, 11 L. Ed. 957, 960, a claimant of goods seized on suspicion of fraudulent importation sought to prove their cost by opinions of merchants as to the value, rather than by his actual books of account which would have shown the actual price paid. This Court held that the burden of the case was on the claimant and that his failure to produce the accounts warranted a presumption that, if produced, they would have been unfavorable to his case. In its opinion, this Court said:

> "One of the general rules of evidence, of universal application, is, that the best evidence of disputed facts must be produced of which the nature of the case will admit. This rule, speaking technically, applies only to the distinction between primary and secondary evidence; but the reason assigned for the application of the rule in a technical sense is equally applicable, and is frequently applied to the distinction between the higher and inferior degree of proof, speaking in a more general and enlarged sense of the terms, when tendered as evidence of a fact. The meaning of the rule is, not that courts require the strongest possible assurance of the matters in question; but that no evidence shall be admitted, which, from the nature of the case, supposes still greater evidence behind the party's possession or power; because the absence of the primary evidence raises a presumption, that, if produced, it would give a complexion to the case at least unfavorable, if not directly adverse to the interest of the party."

In *Backus v. Owe Sam Goon,* 235 Fed. 847, in the Court of Appeals for the Ninth Circuit, the Government

in a deportation proceeding, sought to sustain its burden of proving that the alien had been in Mexico by the testimony of a witness who identified a photograph of the alien as that of a Chinese he had seen in Mexico. The Court held this proof insufficient because the question whether the alien had been working in a certain place in Mexico was capable of easy proof by competent testimony. The Court's opinion states (p. 852):

> "The rule of law respecting evidence demands of a party seeking to establish a fact that he produce the best evidence available to him. Greenleaf on Evidence (16th Ed.) sec. 81; Wigmore on Evidence, sec. 1173; Jones on Evidence, Vol. 2, sec. 212."

In *Longini Shoe Manufacturing Co. v. Ratcliff,* 108 F. 2d 253, 44 U. S. P. Q. 28, decided by the Court of Customs and Patent Appeals in 1939 the fact situation is strikingly similar to that in the instant case, but the Court's decision was opposite: There the appellant was seeking to cancel a Trade Mark registration by proof of use prior to the appellee's application date, and accordingly bore the burden of proof, as stated by the Commissioner's decision 38 U. S. P. Q. 547 at 548, which was being affirmed by the Court. On direct examination the appellant's witness Longini testified that his first sale of any consequence of goods bearing the mark was made January 8, 1936, and he introduced the written order for the goods as Exhibit 2.

On the cross-examination of Longini, testimony was developed to the effect that some shoes bearing the mark

were ordered in August and shipped in October 1935, and also that there was a letter at Longini's office showing that the goods bore the mark and stating they were being shipped. This letter, discovered by appellee's counsel on cross-examination to be in Longini's possession, was not demanded, nor was it introduced in evidence by either side.

The following excerpt from the Court's opinion shows that the situation was similar to the present one:

> "Counsel for appellant argues that 'great probative force' should be given the testimony of the witness Longini as to the sale and shipment of the sample shoes to the Spiegel, May, Stern Company, because it was adduced on cross-examination, and that, because counsel for appellee did not request the witness to produce the letter referred to in the testimony, the testimony of the witness 'must be accepted as conclusive'; whereas, counsel for appellee argues that, due to the failure of appellant to produce the letter referred to by the witness, the fair presumption is that had it been produced it would have been detrimental to appellant's case. In support of his contention counsel for appellee calls attention to the following from Jones on Evidence, Fourth Edition, Vol. 1, sec. 19, page 49:" (108 F. 2d at 256.)

* * * * * * * *

> "Testimony adduced on proper cross-examination is to be regarded as though it were adduced on direct examination.

* * * * * * * *

> "We are of opinion, therefore, that the rule hereinbefore stated, relative to the failure to produce the most satisfactory evidence, is here applicable, and that had the documentary evidence to which reference was made on cross-examination by the witness Longini been produced it would have been detrimental to appellant's case." (P. 257.)

The Court supported its decision on this point by citing *Clifton v. United States,* 4 How. 242, *supra,* and *Backus v. Owe Sam Goon,* 235 Fed. 847, *supra.*

> "The rule as to the burden of proof . . . constitutes a substantial right of the party upon whose adversary the burden rests." (22 C. J., Sec. 14, pp. 69 and 70.)
>
> "The burden never shifts from the party having the affirmative of the issue." (22 C. J., Sec. 14, p. 69.)

It is submitted that the development of facts by cross-examination should not alter the Petitioner's substantial right." The decision of the Court of Customs and Patent Appeals in the instant case would impose on a party the obligation of perfecting a defect in his opponent's case or proving the negative thereof, by demanding evidence which his opponent has not introduced. It is the purpose of cross-examination to expose omissions in an opponents' proofs, and there should be no penalty for doing so. The Court's doctrine in the present case should be rejected; and its doctrine in the *Longini* case should be upheld.

Argument Relating to Respondent's Abandonment.

The findings and rulings of the Board, concurred in or not disturbed by the Court, were that:

(1) Respondent conceived and built a model, Exhibit 8, of the invention in 1933 [R. 614] followed by complete inactivity until the filing of the Learned patent application on April 11, 1944, at the Government's request [R. 619, 628] except for the correspondence with the National Inventors' Council and some correspondence with Hunter at a later undetermined date [R. 618].

(2) There is no estoppel against Respondent because there is no evidence from which it can be inferred that the National Inventors' Council's recommendation that Respondent file his patent application after his admitted suppression of the invention, was induced by knowledge of the fact that Thompson had submitted his idea to the Office of Strategic Services prior to this time [R. 628].

Learned's admission of suppression and abandonment following his 1933 model, appears as follows [R. 127-128]:

> "I decided that the wisest course would be to suppress the thing.
>
> XQ. 121. So you thereupon suppressed the device? A. Yes.
>
> * * * * * * * *
>
> XQ. 125. You thought, then, it would be a device that would be well forgotten, I suppose? A. I thought so then, and other people have joined me in so thinking since."

Learned gave no excuse for his suppression and long delay in filing except his inadequate explanation of his inability to market the device to the Boy Scouts and his fear that the device, if known, would be dangerous to the nation and to children [R. 127, 128].

Petitioner's contention to both the Board and Court were that this testimony coupled with Respondent's inactivity after 1933 proves abandonment, laches and suppression, thereby preventing an award of priority to him [R. 628, 683, 686, 720].

In not holding that Respondent abandoned his invention under the foregoing circumstances before filing his patent application, the Court of Customs and Patent Appeals has not followed the long line of decisions summed up in the opinion of this Court in *Electric Storage Battery Company v. Shimadzu, et al.*, 307 U. S. 5, 83 L. Ed. 1071, 1078, wherein the Court speaking through Mr. Justice Roberts stated:

> "A patent is not validly issued if the invention 'is proved to have been abandoned.' Abandonment may be evidenced by the express and voluntary declaration of the inventor; it may be inferred from negligence or unexplained delay in making application for patent; it may be declared as a consequence of the inventor's concealing his invention and delaying application for patent in an endeavor to extend the term of the patent protection beyond the period fixed by the statute. In any case the question whether the invention has been abandoned is one of fact."

In *Kendall v. Winsor*, 21 How. (62 U. S.) 322, 328 16 L. Ed. 165, this Court said:

> ". . . he may forfeit his rights as an inventor by a wilful or negligent postponement of his claims

or by an attempt to withhold the benefit of his improvement from the public until a similar or the same improvement should have been made and introduced by others."

Since the Board's decision was in favor of Petitioner he did not need to take a cross appeal to the Court from the Board's decision in order for the Court to consider the points on abandonment, laches and suppression not decided in his favor by the Board. (*Botnen v. Dorman,* 179 F. 2d 249, 37 C. C. P. A. 813; *Draeger et al. v. Bradley,* 156 F. 2d 64, 33 C. C. P. A. (Patents) 1130, 1135.)

The question of abandonment is held ancillary to priority, so that if Respondent abandoned, priority should go to Petitioner. (*Bain et al. v. Hasselstrom et al.,* 165 F. 2d 436, 35 C. C. P. A. 811.)

Conclusion.

The matters of law involved in Questions 1, 2 and 3 are of great importance to the Public, and should be settled by this Court.

Respectfully submitted,

D. Gordon Angus,

Attorney for Petitioner.

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Judicial Code, Sec. 195, as amended, 38 Stat. 703; 46 Stat. 590, 762; 28 U. S. C. (1946 ed.) 308	5
R. S. 4911, as amended, 27 Stat. 436, 44 Stat. 1335, 1336; 45 Stat. 1476; 53 Stat. 1212; 35 U. S. C. 59a	8
R. S. 4914, 35 U. S. C. 62	9
28 U. S. C. 1256	5, 6
28 U. S. C. 1541	6

In the Supreme Court of the United States

OCTOBER TERM, 1951

No. 496

KENNETH B. THOMPSON, *Petitioner*

v.

CHARLES H. LEARNED

On Petition for a Writ of Certiorari to the United States Court of Customs and Patent Appeals

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BRIEF FOR THE RESPONDENT IN OPPOSITION

OPINIONS BELOW

The opinion of the Board of Interference Examiners (R. 613-635) is unreported. The opinion of the Court of Customs and Patent Appeals (R. 687-700) is reported at 191 F. 2d 409.

JURISDICTION

The decision of the Court of Customs and Patent Appeals was entered on June 29, 1951 (R. 700-701).

A petition for rehearing was denied on September 28, 1951 (R. 717). The petition for a writ of certiorari was filed on December 27, 1951. Petitioner invokes the jurisdiction of this Court under 28 U.S.C. 1256.

QUESTION PRESENTED

Whether this Court has jurisdiction to issue a writ of certiorari to review a decision of the Court of Customs and Patent Appeals awarding priority of invention to respondent.

STATUTES INVOLVED

The pertinent parts of the statutes involved are set forth in the Appendix, *infra,* pp. 8-10.

STATEMENT

This is an action arising out of an interference proceeding set up in the Patent Office to determine the priority of invention among the patent applications of four parties, each claiming to be the original and first inventor of a signalling device.[1]

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[1] The present interference is a consolidation of Interference No. 82,373 which involved petitioner, respondent, and the parties Richard S. Hunter, an employee of the Bureau of Standards, and Larry L. Young; and Interference No. 83,032 which originally involved the same parties with the exclusion of Young (R. 612). Judgment was entered against Young in view of his failure to take testimony (R. 58); Hunter filed an abandonment of the contest before the taking of testimony (R. 56-57). The United States has a non-exclusive license under respondent's application under which it assumed the prosecution of his application.

The Board of Interference Examiners of the United States Patent Office awarded priority of invention of the subject matter to petitioner (R. 613-628), with one member dissenting (R. 629-635). On appeal to the United States Court of Customs and Patent Appeals, the decision of the Board of Interference Examiners was reversed and priority of invention awarded to respondent (R. 687-700).

ARGUMENT

The decision of the court below awarding priority of invention to respondent, depending as it does upon the evaluation of testimony and presumptions, is, for the reasons set forth in the court's opinion (R. 687-700), clearly correct and does not warrant review by this Court. Moreover, this Court has long held that it has no constitutional power to review decisions of the lower appellate courts in summary appeals taken under R. S. 4911-4914, *infra*, pp. 8-10, from decisions of the Patent Office in patent and trademark cases.

In the leading case of *Postum Cereal Company* v. *California Fig Nut Company*, 272 U. S. 693 (a trademark case), this Court held that a decision of the Court of Appeals of the District of Columbia in a summary appeal taken from a decision of the Patent Office was "not a judicial judgment," but was "merely an instruction * * * by a court which is made part of the machinery of the Patent Office for administrative purposes" (pp. 698-699). Consequently, such a proceeding was con-

sidered not to be a case or controversy, in the constitutional sense, which this Court was authorized to review.

Subsequent to the decision in the *Postum Cereal Company* case, authority to determine summary appeals taken from decisions of the Patent Office in patent and trademark matters under R. S. 4911-4914 was transferred from the Court of Appeals of the District of Columbia to the newly named Court of Customs and Patent Appeals. Act of March 2, 1929, c. 488, 45 Stat. 1475-1476, *infra*, p. 8.[2] After the transfer of this authority to the Court of Customs and Patent Appeals had taken place, this Court in denying, for want of jurisdiction, petitions for writs of certiorari to that court in *Pacific Northwest Canning Company* v. *Skookum Packers' Ass'n*, 283 U. S. 858 (a trademark case), and *McBride* v. *Teeple*, 311 U. S. 649 (a patent case), cited the *Postum Cereal Company* case as authority for its denial of the writs, thus affirming its prior holding that it had no jurisdic-

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[2] The Court of Customs and Patent Appeals may properly be given authority to determine both justiciable and non-justiciable matters. *Ex parte Bakelite Corp.*, 279 U. S. 438. In this connection, summary appeals in patent and trademark matters are to be distinguished from appeals taken to the Court of Customs and Patent Appeals from judgments of the United States Customs Court entered in customs cases. The latter are unquestionably judicial in character and are reviewable by this Court. See, *e. g.*, *Barr* v. *United States*, 324 U. S. 83; *Board of Trustees of University of Illinois* v. *United States*, 289 U. S. 48.

tion to review decisions in summary appeals taken from Patent Office determinations in patent and trademark matters.[3]

Petitioner invokes 28 U. S. C. 1256, *infra*, p. 8, to sustain the jurisdiction of this Court to grant the writ of certiorari and review the decision of the court below. Section 1256 is a part of the Act of June 25, 1948, 62 Stat. 869, codifying into law Title 28 of the United States Code. Prior to the effective date of the 1948 Act, the only statutory provision authorizing this Court to review decisions of the Court of Customs and Patent Appeals was Section 195 of the Judicial Code as amended.[4] That section, which empowered the Court of Customs and Patent Appeals to hear appeals from the Customs Court and authorized this Court to review the decisions of the Court of Customs and Patent Appeals in such cases, related only to customs cases. It did not refer to either patent or trade-

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[3] Petitioner's reliance (Pet 2) on *Magnum Co.* v. *Coty*, 262 U. S. 159; *Clifton* v. *United States*, 4 How. 242; and *Electric Storage Battery Co.* v. *Shimadzu*, 307 U. S. 5, as sustaining the jurisdiction of this Court in the instant case, is entirely misplaced. Those cases did not involve summary appeals taken under R. S. 4911-4914 from decisions of the Patent Office to the Court of Customs and Patent Appeals or its predecessor in such matters. They all involved normal appeals which had been taken from judgments and decrees of United States District Courts, and are thus plainly inapposite.

[4] Section 195 was amended by the Act of August 22, 1914, 38 Stat. 703, and by Section 647 of the Tariff Act of 1930, 46 Stat. 590, 762, 28 U. S. C. (1946 ed.) 308.

mark matters. In the Act of June 25, 1948, Congress merely separated the two provisions—placing in 28 U. S. C. 1541 the authority of the Court of Customs and Patent Appeals to hear appeals in customs cases, and in Section 1256 the authority of this Court to review by writ of certiorari cases in the Court of Customs and Patent Appeals. Nothing in the 1948 Act, codifying into law Title 28 of the United States Code, or its history indicates that there was any intention on the part of Congress to give this Court authority to review a class of cases over which its jurisdiction had previously been withheld, or to diminish the ambit of the *Postum Cereal Company* case.

For a fuller discussion of this Court's lack of jurisdiction to review decisions in summary appeals taken from decisions of the Patent Office in patent and trademark matters, including a brief history of such appeals, and for citations of other cases wherein this Court has declined to review such decisions, we respectfully refer the Court to the respondent's Brief in Opposition (pp. 3-9) in the case of *Dalton and Cooley* v. *Marzall, Commissioner of Patents,* No. 87, this Term, certiorari denied, 342 U. S. 818.

CONCLUSION

It is respectfully submitted that, for the reasons stated above and in the respondent's Brief in Opposition in *Dalton and Cooley* v. *Marzall, supra,* the petition for a writ of certiorari should be

denied for want of jurisdiction as in *McBride* v. *Teeple*, 311 U. S. 649.[5]

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FEBRUARY 1952.

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[5] It would be helpful in the future disposition of cases of this class if this Court, in disposing of the instant case, would indicate whether or not it has jurisdiction to review decisions of the Court of Customs and Patent Appeals in such cases.

APPENDIX

Act of March 2, 1929, c. 488, 45 Stat. 1475-1476:

> That the title of the United States Court of Customs Appeals, created by the Act approved August 5, 1909, is hereby changed to the United States Court of Customs and Patent Appeals.
>
> Sec. 2(a) The jurisdiction now vested in the Court of Appeals of the District of Columbia in respect of appeals from the Patent Office in patent and trade-mark cases is vested in the United States Court of Customs and Patent Appeals.

28 U. S. C. 1256:

> Cases in the Court of Customs and Patent Appeals may be reviewed by the Supreme Court by writ of certiorari.

Section 4911 R. S., as amended, 27 Stat. 436, 44 Stat. 1335, 1336; 45 Stat. 1476; 53 Stat. 1212; 35 U. S. C. 59a:

> Sec. 4911. If any applicant is dissatisfied with the decision of the board of appeals, he may appeal to the United States Court of Customs and Patent Appeals, in which case he waives his right to proceed under section 4915 of the Revised Statutes. If any party to an interference is dissatisfied with the decision of the board of interference examiners, he may

appeal to the United States Court of Customs and Patent Appeals, provided that such appeal shall be dismissed if any adverse party to such interference shall, within twenty days after the appellant shall have filed notice of appeal according to section 4912 of the Revised Statutes, file notice with the Commissioner of Patents that he elects to have all further proceedings conducted as provided in section 4915 of the Revised Statutes. Thereupon the appellant shall have thirty days thereafter within which to file a bill of equity under said section 4915, in default of which the decisions appealed from shall govern the further proceedings in the case.

Section 4914 of the Revised Statutes, 35 U. S. C. 62:

The court [Court of Customs and Patent Appeals], on petition, shall hear and determine such appeal, and revise the decision appealed from in a summary way, on the evidence produced before the commissioner, at such early and convenient time as the court may appoint; and the revision shall be confined to the points set forth in the reasons of appeal. After hearing the case the court shall return to the commissioner a certificate of its proceedings and decision, which shall be entered of record in the Patent Office, and shall

govern the further proceedings in the case. But no opinion or decision of the court in any such case shall preclude any person interested from the right to contest the validity of such patent in any court wherein the same may be called in question.

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